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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,469	08/20/2004	Frederic Fortin	09955.0047-00000	4004
22852	7590	05/08/2009	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			WOODALL, NICHOLAS W	
ART UNIT	PAPER NUMBER			
3775				
MAIL DATE	DELIVERY MODE			
05/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/505,469	<b>Applicant(s)</b> FORTIN ET AL.
	<b>Examiner</b> Nicholas Woodall	<b>Art Unit</b> 3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 February 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 20-34 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 20-34 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449)  
 Paper No(s)/Mail Date 02/06/2009.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/06/2009 has been entered.

#### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 07/18/2001. It is noted, however, that applicant has not filed a certified copy of application FR 01/09628 as required by 35 U.S.C. 119(b).

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 20, 21, 24, 25, 28, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Navaz (U.S. Patent 5,375,823).

Navaz discloses a device comprising a cylindrical body, a first rod (11) extending from the first end of the cylindrical body in a first direction, a second rod (30) having an elongated body that extends in a second direction opposite the first direction and an

enlarged head portion (3) positioned within the cylindrical body, a first dampening member (4) positioned between the enlarged end portion and the first end of the body, wherein the first dampening member does not surround the second rod, a second dampening member (6) positioned between the enlarged end and the second end of the cylindrical body, wherein the second dampening member is ring-shaped with an opening (6A) that receives the elongated body of the second rod, and a threaded cap (2) threaded into a threaded portion of the second end of the cylindrical body including a circular opening (20) having a width greater than the elongate body of the second rod capable of allowing the second rod to bend, i.e. translate within the opening, with respect to the cylindrical body. Navaz further discloses a method of joining vertebral implant comprising the step of providing the device as discussed above.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22, 26, 29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Navaz (U.S. Patent 5,375,823).

Navaz discloses the invention as claimed except for the threaded cap including an inner threaded region and the opening in the cap being eccentrically located on the cap.

Regarding the cap including an inner threaded region, Navaz discloses the device wherein the cap includes an externally threaded region that engages an inner threaded region of the cylindrical body, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Navaz wherein the cylindrical body includes an outer threaded region and the cap includes a complementary inner threaded region, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art.

In re Einstein, 8 USPQ 167.

Regarding the opening in the cap being eccentrically located on the cap, Navaz teaches a device wherein the opening is centrally located on the cap and the applicant shows in the Figures that the opening may be eccentrically or centrically located on the cap providing evidence that the location of the opening in the cap is not critical to the invention. Therefore the examiner believes it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Navaz wherein the opening in the cap is eccentrically located on the cap, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

The device of Navaz as modified above in view of the case-law rulings discloses a method comprising the steps of providing the device as discussed above.

7. Claims 23 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Navaz (U.S. Patent 5,375,823) in view of Alby (U.S. Patent 6,241,730).

Navaz discloses the invention as claimed except for the first rod having a threaded end engaging a threaded portion of the cylindrical body. Navaz disclose the device having a first rod that is integrally formed with the first end of the cylindrical body. Alby teaches a device comprising a cylindrical body (13) and a first rod (4A), wherein the first rod includes a threaded portion (15) engaging a threaded portion (13) of the cylindrical body in order to allow for easier replacement of the first rod without having to remove the entire device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Navaz wherein the first rod includes a threaded portion engaging a threaded portion of the cylindrical body in view of Alby in order to allow for easier replacement of the first rod without having to remove the entire device.

The device of Navaz as modified by Alby discloses a method comprising the steps of providing the device as discussed above.

8. Claims 27 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Navaz (U.S. Patent 5,375,823) in view of Belogour (U.S. Patent 5,503,413).

The device of Navaz discloses the invention as claimed except for the opening in the cap having an oblong shape. Belogour discloses a device comprising a shock absorbing element, wherein the shock absorbing element includes a rod (20) that extends through an oblong opening (38) in order to provide full compression of the shock absorbing element at an angle (column 4 lines 1-7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the

device of Navaz wherein the opening in the cap includes an oblong shape in view of Belogour in order to provide full compression of the device at an angle.

***Response to Arguments***

9. Applicant's arguments with respect to claims 20-34 have been considered but are moot in view of the new ground(s) of rejection. The applicant's argument that the examiner provided new arguments in the final office action and that the after-final amendment should have been entered to allow the applicant to respond to those arguments is not persuasive. First, the after-final amendment filed on 01/06/2009 included arguments to the examiner's office action and amendments to the claims that added limitations not previously considered by the examiner. Therefore, any after-final amendment including amendments to the claims that require further search and/or consideration are not to be entered since prosecution of the application is closed. Second, if the after-final amendment would have only comprised a request for reconsideration and the applicant's arguments directed to the final office action, the examiner would have entered the after-final amendment and responded to the applicant's arguments, but the amendment further included claim amendments as discussed above and was therefore properly not entered.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
Unit 3775